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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,892	01/26/2004	Tsutomu Okada	17376	9699

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,892

Applicant(s)

OKADA, TSUTOMU

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on February 16, 2006, amended claims 1-2 and 13; and new claims 14-18 are acknowledged. The rejections of claims 1-7, and 11-12 under 35 USC § 102(b) *stand*. The rejection of claims 8-10 under 35 USC § 103(a) is *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (U.S. Patent No. 6,059,719).

**In regard to claims 1-7, 11 and 12**, Yamamoto et al. teach an endoscope system 1 comprised of an endoscope 2 having an insertion unit 11 with a distal part 16 that is provided with a connecting tool 21 that couples with a connecting tool 8 on an endoscope module 6 (see Figures 1 and 2). Yamamoto et al. teach an embodiment of a module 6A where an incision device 9a comprised of a snare 94 attached to the distal end of an operation tube 23 (see Figure 7). A transmission wire 22 for operating the snare 94 extends within the tube 23 and is able to move forward and backward (see Figure 7 and col. 10, lines 35-45). First handle 99a and second handle 99b coupled to the proximal end of tube 23 operate the wire 22 and Figures 9-12 and 15 show hoe the

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snare 64 projects from the distal end of tube 23 and expands and is stored within the module 6 when slid proximally. **In regard to claim 13**, see col. 10, lines 5045.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Seuberth et al. (U.S. Patent No. 3,805,791).

**In regard to claim 1**, Seuberth et al. teach an apparatus for the diathermic removal of growths comprised of a tubular member 2 that houses a loop slider 4 to which is attached a wire loop 5 (see Figure 1 ). Wire loop 5 is held within the tubular member 2 until actuated by loop slider 4 to protrude from the distal end of the tubular member 2 (see Figures 2-4).

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakada et al. (U.S. Patent Application Publication No. 2001/0053909)

**In regards to claims 1-7 and 11-16**, Nakada et al. teach a diathermic snare used in combination with an endoscope, the endoscope 3 including an inserting section 4 with is inserted into a body cavity and which has a distal end and a proximal end, and a cylindrical cap section 1 mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection having a bending portion that bends inward at the distal end of the cap section (see Figs. 1 and 3), wherein the diathermic snare comprises: an elongate flexible sheath 9 having a distal end and a proximal end; an operating wire inserted into the sheath so as to move forward and backward and having a distal end and a proximal end; a snare wire 16b coupled to the distal end of the operating wire and having a loop section which expands like a loop (see Fig. 4); an operating section coupled to the proximal end of the sheath

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and including a operating section coupled to the proximal end of the sheath and including a guide member extending in an axial direction of the sheath and a slider which moves forward and backward in the axial direction of the sheath along the guide member and which is coupled to the proximal end of the operating wire; the loop section of the snare wire projecting from the distal end of the sheath, the snare wire expanding like a loop, and the loop section expanding along an inner circumference of the engagement projection when the slider moves toward along the guide member (see Figs. 3-6) ; and a bending portion provided at the distal end of the loop section, the bending portion ending in a direction that intersects a plane formed by the loop section and conforming to a corner of the bending portion of the engagement projection when the loop expands along the inner circumference of the projection (see Figs. 1 and 5-6); wherein the cap section has an inclined plane corresponding to a plane of the cap section which is inclined to the axial direction of the sheath and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8).

**In regards to claims 8-10 and 17-18,** Nakada et al. teach a diathermic snare used in combination with an endoscope, wherein cap section has an inclined plane corresponding to a plane of the distal end of the cap section which is inclined to the axial direction of the sheath; and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8).

### ***Response to Arguments***

Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the advantages gained by a diathermic snare) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant states neither Yamamoto or Seuberth disclose any structural element corresponding to the distal-end portion bendable in the direction that intersects the plane formed by the loop section. However, both Yamamoto or Seuberth disclose an apparatus used with a flexible insertion part of an endoscope which is inherently capable of being bent in any desired direction, as it is well known in the art. Thus as broadly as claimed, both Yamamoto and Seuberth disclose a structural element (i.e. the flexible insertion part of the endoscope) bendable in a direction that intersects the plane formed by the loop section.

Furthermore, applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *MJK*

4/26/06



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